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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,506	01/27/2004	Yoshiro Yamazaki	Q79544	9257
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EXAMINER				
CUNNINGHAM, GREGORY F				
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04/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/764,506

**Applicant(s)**

YAMAZAKI ET AL.

**Examiner**

GREGORY F. CUNNINGHAM

**Art Unit**

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/27/2004 and interview dated 2/4/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 7-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 14-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications of application received 1/27/2004 and phone interview dated 2/4/2008.
2. The disposition of the claims is as follows: claims 1 – 6 and 14 - 23 are pending in the application. Claims 1 and 14 are independent claims. Claims 7 - 13 have been withdrawn. Claims 15 - 23 were newly added.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 14 may broadly be interpreted as using glasses to “optically read” whatever is being displayed, and an individual, person, or user to use the glasses and mentally “recognize” and “extract”.

Therefore claim 14 does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 - 6 and 14 - 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 1 and 14 cite "a reading component for optically reading an electronic paper which is filled out by hand, in a state in which a first image which has been recorded on the electronic paper in advance, being displayed" may be broadly interpreted as a pair of reading glasses which corresponds to "reading component"; and whereby "for optically reading an electronic paper which is filled out by hand, in a state in which a first image which has been recorded on the electronic paper in advance, being displayed" corresponds to intended use.

B. Furthermore, it is not clear what is "being displayed". Reading component, electronic paper, or a state in which a first image which has been recorded on the electronic paper in advance?

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claim 14 is rejected under 35 U.S.C. 102(a) as being anticipated by "Seeing and Visualizing: It's Not What You Think" by Zenon Pylyshyn, hereinafter Pylyshyn.

A. Pylyshyn discloses claim 14, "An electronic paper reading method comprising the steps of:

(a) optically reading an electronic paper which is filled out by hand in a state in which a first image which has been recorded on the electronic paper in advance, is being displayed [Pylyshyn, page 1-10 shows the eye "optically reading" any information before the eyes, especially if one is to fill out an electronic paper by hand, this is not done with one's eyes closed, but rather open and thus project's onto an inner screen for the "mind's eye" as depicted in Figure 1-9];

(b) recognizing the first image [Pylyshyn, page 1-6, see Figure 1-5]; and

(c) extracting [Pylyshyn, page 4-13 at 4.5.2 Extracting visual information from within and between objects The notion that objects are detected as such and then visual properties are bound to them at a very early stage in visual perception has also received support from many studies showing that it is faster to report several features or properties if they are associated with the same object. Also features that are part of different objects interfere less in a search task. For example, (Duncan, 1984) and later (Baylis & Driver, 1993) showed that access to relational properties of two features (such as "larger than") is faster when the features in question belong to the same perceptual object than when they are parts of different objects, even when they are the same distance apart.], from a result of the reading in the step (a), image data of a second image that represents contents with which the electronic paper is filled out by hand, based on a recognized result from the first image in the step (b)" supra [as detailed].

#### **Examiner's Comment**

7. In general use of the terms "for", "to", "configure to" usually associate intended use and does not necessarily assert that which follows as occurring.

***Responses***

8. Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

***Inquiries***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory F. Cunningham whose telephone number is (571) 272-7784.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Bella can be reached on (571) 272-7778. The Central FAX Number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Greg F Cunningham/

Examiner, Art Unit 2624

4/7/2008

/Matthew C Bella/

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Supervisory Patent Examiner, Art Unit 2624